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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,982	02/01/2002	Ken Kutaragi	SCEIYA 3.0-117	9131
530	7590	03/16/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			THOMPSON, MARC D	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,982

Applicant(s)

KUTARAGI ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date see action.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.
2. The amendment, received 11/21/2005, has been entered into record.
3. Claims 1-3, and 5-24 remain pending.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
5. The effective filing date for the subject matter defined in the pending claims in this application which have support in the earliest filed foreign application being relied on for priority (i.e., JAPAN 2001-25532), is 2/1/2001.

Information Disclosure Statements

6. Four IDS (PTO-1449) have been considered, and are included with the present action. There forms were received on 7/1/2002, 10/14/2003, 7/12/2004, and 6/6/2005, respectively.

Drawings

7. The Examiner contends that the drawings submitted on 5/23/2002 are acceptable for examination proceedings.

Double Patenting

8. No double patenting rejections are deemed appropriate at this time. If Applicant is aware of any of the dozens of copending application(s) sharing assignee and common inventor(s) which share substantially claimed subject matter, Applicant is requested to provide the application/patent numbers for future comparison/examination in regard to double patenting.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-3 and 5-24 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 1-3 and 5-24 recite “user status” which relates to “the state of at least one of the programs or data stored in the recording medium or the user computer...so that the user computer can receive requested information from the desired content server”. It is unclear how the label “user status” or “user state” can reasonably relate to information not at all related to the user. For example, in claim 1 no user is specifically recited, and the “user status” relates to the status of at least one program and data stored in the recording medium” (Lines 27-30). Also, given the breadth of disclosure and lack of specific definition of the term “user state”, and an inability of one of ordinary skill in the art at the time of invention to easily ascertain the metes and bounds of the limitation “user state”, the claims are simply indefinite. Since no concrete definition for “user state” can be determined, any interpretation is left open to speculation. For

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the purposes of interpretation, this limitation will be considered broad enough to include any portion of resident data on a [user] computer.

12. The majority of the claims recite “means-plus-function” language without any specific reference to any corresponding structure set forth in the current specification. If interpretation using 35 USC §112, sixth paragraph is intended, section of the specification relied upon for proper interpretation of the claims is required.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

14. Claims 1-3 and 5-24 are rejected under 35 U.S.C. §102(e) as being anticipated by Walker et al. (U.S. Patent Number 6,110,041), hereinafter referred to as Walker.

15. Walker disclosed determining a unique identification number associated with a particular recording medium and user, minimally, since the user identification was unique and stored on a removable storage device. See, inter alia, Column 6, Lines 39-67, Column 7, Lines 47-63, and Column 8, Lines 1-6. Walker disclosed a verification server including a user database storing the identification number(s) and effecting verification of an information request and access and delivery of content from a server in response to request verification. See, inter

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alia, Column 5, Lines 37-41, and Column 8, Lines 4-6. Information relating to a current or intended state of the user (prior accumulated points, preferred preferences, etc.) stored in and retrieved from content servers was fully disclosed, inter alia, in Column 5, Lines 1-16, and Column 5, Lines 42-60. Content server(s) were disclosed as enabled to deliver digital information to the user in response to verification as well as preparation of delivered information based on the received and/or stored user state information. See, inter alia, Column 5, Lines 42-60, and Column 8, Lines 53-59. Reconfiguration of the functionality of the stored program(s) and the specification of a particular program at the system server(s) was reasonably encompassed in a definition of a program, program version, or a serial number, as claimed, to one of ordinary skill in the art at the time of invention. For example, see, Column 3, Line 65 through Column 4, Line 5, and Column 8, Lines 23-39, when considering any (re)configuration of the software defines a particular software state/version.

16. Since Walker disclosed all the limitations set forth in the claimed invention, claims 1-3 and 5-24 are rejected.

17. Claims 1-3 and 5-24 are rejected under 35 U.S.C. §102(e) as being anticipated by Collart (U.S. Patent Number 6,665,489), hereinafter referred to as Collart.

18. Collart disclosed the use of burst cut area (BCA) numbers acting as electronic medium storage medium unique identification numbers utilized to regulate transfer of information over a network. See, inter alia, Abstract, Column 6, Lines 7-12, Column 7, Lines 7-51, and Column 7, Lines 55-63. These sections also specifically enable myriad implementations using (essentially) any type of storage medium, as does Columns 35-40. Collart disclosed an entire collection of

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functional uses for unique medium identification numbers combined with user/machine specific information, including unlocking content on the medium itself (inter alia, Column 19, Lines 15-30, and Column 24, Lines 4-51), delivery of content over a network (inter alia, Column 20, Lines 10-44, Column 22, Lines 19-25), updating of application and content versions using the network (inter alia, Column 22, Lines 41-57), and access regulation of content based on user identity (inter alia, Column 23, Lines 60-67), to cite a few. The provision for utilizing the BCA number information both alone and in combination with other “locally” stored or input user information, including user identification, machine identification, and network databases was evident for the majority of the exemplified embodiments. See, inter alia, Column 20, Lines 2-5, Column 23, Lines 60-62, and Column 24, Lines 10-12. Medium specific support information was further disclosed, which enabled any combination of BCA information and verified user/machine information utilized for retrieval of associated content with particular, identified mediums (i.e., disc-specific), and updates, versions, and application services for content delivery and rendering. See, inter alia, Column 25, Line 7 through Column 26, Line 46.

19. Since Collart disclosed all the limitations set forth in the claimed invention, claims 1-3 and 5-24 are rejected.

Response to Arguments

20. The arguments presented by Applicant in the response, received on 11/21/2005, are not considered persuasive.

21. Applicant argues the prior art of record “does not disclose or suggest the state of at least one of the programs or data stored in the recording medium or the user computer”, and “[the

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prior art of record] fails to disclose at least the feature of requesting or providing user status information representing a current status of at least one of programs and data stored in the recording media or the users computers and so that the user computer can receive requested information from the desired content server". See, inter alia, Response, received 11/21/2005, Page 17, Last Paragraph through Page 18. It is submitted that not only does the current prior art of record expressly disclose this overly broad characterization of the described invention, but the breath of this argument fails to recognize multiple alternate embodiments which have nothing at all to with the disclosed invention. Indeed, the disclosure remains broad enough to fail to isolate a particular type of state information, including program versions and saved game information. Significant discussion about the metes and bounds of what is intended to be claimed is suggested for advancement of prosecution.

22. The art (both applied and other art of record) clearly provided indication of the use of state information, optionally stored on myriad recording mediums including optical discs, for the purpose of identifying authorized transfer and storage and access of digital information. Applicant is requested to significantly define what combinations of features is considered to be patentable over the entirety of the prior art of record, previously, and presently cited. This means Applicant is responsible for the entirety of art submitted, as well as the entirety of each specification above and beyond any cited sections. See, inter alia, MPEP §2123. The significant modification to the claimed invention in the response seems well beyond any minimal scope of the submitted arguments. Given the new art as applied, it is suggested that careful review of all art take place, and further limiting of the claimed invention occur for proper determination of patentability in light of claim scope and content of art.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Careful consideration should be given to all art of record when preparing a response to this office action to avoid future rejections.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn, Jr., can be reached at 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON
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PRIMARY EXAMINER

Marc D. Thompson
Primary Examiner
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